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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

HENRICSON t al

Serial No. **08/875,424**

Filed: **July 28, 1997**

Atty. Ref.: **30-440**

Group: **1731**

Examiner: **Alvo**

For: **METHOD OF PRETREATING PULP TO BE BLEACHED WITH PEROXIDE**

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#10 Don't Compliance Ltr

August 23, 1999

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(c) AND CONTINGENT PETITION FOR REVIEW OF THE PROPRIETY OF THE ISSUANCE OF THE NOTICE OF NON-COMPLIANCE

The Notification of Non-Compliance is totally erroneous in rejecting the Appeal Brief on formal grounds for failure to specifically address claims 36 through 46 under the "Issues" since -- as an inspection of the Final Rejection makes clear -- nowhere is there any specific rejection given of these claims. However, rather than argue this point, appellants submit herewith a Brief which specifically provides the "phantom" rejection of these claims in a heading.

With respect to the allegations bridging pages 3 and 4 of the Notification of Non-Compliance it is erroneous *per se*. As clearly and unequivocally pointed out at the bottom of page 12 of the original Brief, appellant has not merely argued that the features in the claims are not shown in the art but has specifically said

> "Further there simply is no suggestion within any reference as to why anyone of ordinary skill would modify the references to teach these features, and therefore clearly no *prima facie* case of obviousness. The PTO has not discharged its duty to prove a *prima facie* case by facts with respect to any of these claims. Therefore all of the claims clearly patentably distinguish from the art."

It is particularly ironic that the Notification of Non-Compliance would suggest that appellants have not discharged their duty to specifically argue individual claims when the Final Rejection is completely and totally devoid of any mention whatsoever of claims 17 through 19, 21, 22, and 24 through 34 (or indeed even lists claims 36 through 46). Rejections based on 35 USC §103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

Since the Final Rejection does not even attempt to address these claims, it cannot be surprising that appellants do not discuss the claims in any more detail than is provided in the Appeal Brief. Apparently what the Notification of Non-Compliance wants is to for appellants to argue against themselves, an unreasonable requirement to be sure.

It is noted that although claims 36 through 46 are not even mentioned anywhere in the Final Rejection except for the cover page, appellants did originally include completely sufficient arguments with respect to those claims at the top of page 13 of the original Brief. Because of the complaint in the Notice of Non-Compliance that those

claims were not mentioned in the heading (even though they were never mentioned in the Final Rejection), the same arguments as provided in the first paragraph on page 3 of the original Brief are now put under the heading of "The Phantom Rejection of Claims 36 through 46".

To the extent that this is not considered a complete, total and sufficient response to the Notice of Non-Compliance, petition is hereby made for the propriety of the Notice of Non-Compliance; while it is believed no fee is due, if one in fact is, the Patent & Trademark Office may charge Account 14-1140, Our Order No. 30-440.

Also, it is apparent that the appeal conference required by MPEP 1208 has not occurred in this case since if it had been the completely erroneous nature of the Notice of Non-Compliance would have been recognized.

Early reversal of the Final Rejection is respectfully requested.

Respectfully submitted,

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By: _____

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